



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,745	04/09/2004	Michael Snyder	1030.004	1863
25215 7590 08/06/2010 DOBRUSIN & THIENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342				
EXAMINER				
GHALL, ISIS A D				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
08/06/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/821,745

Applicant(s)

SNYDER ET AL.

Examiner

Isis A. Ghali

Art Unit

1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 11, 21, 24-26, 32, 33, 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Smedley et al. (US 7,163,543) combined with Peyman (US 7,354,574).

Claims 22, 27 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smedley and Peyman and further in view of Bardenstein (US 4,743,255).

Claims 23, 29-31, 34-37 and 39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Smedley and Peyman and further in view of Wong et al. (US 6,692,759) as applied to claims 23, 29-30, 36, and over the combination of Smedley, Peyman and Bardenstein and further in view of Wong et al. as applied to claims 31, 34-35, 37 and 39.

Applicant argues that the office action has not presented any facts as to where any reference teaches "a lumen section that extends into the eye and wraps generally circularly around the cornea", so the office action cannot come to the conclusion that claim 11 is obvious. The office action did not point to any facts in either reference that they teach claim 25 that states, "wherein the first end when implanted is located in the anterior chamber of the eye or in the pars plana portion of the eye." Applicants do not believe that the office action has presented a proper prima facie obviousness rejection of this claim and its dependents claims 24 and 32-34. The office action has the burden to show where every element of the claims is taught either expressly or inherently by the references of record. A mere conclusory statement does not create a proper prima facie obviousness rejection.

In response to this argument, it is argued that all the elements of the claims are taught by the combined teachings of the cited references. Smedley teaches clearly, col.3, lines 36-47, glaucoma treatment by permitting aqueous to flow out of the anterior chamber of the eye through a stent to Schlemm's canal with one end of the stent positioned in the anterior chamber and a second end positioned in the Schlemm's canal. Regarding claim 25, the claim requires on end is in either anterior chamber or pars plana, and the reference teaches the anterior chamber. Peyman teaches implantable composition comprises antimicrobial agent in polymer matrix of polycaprolactone contained in a diffusible walled reservoir providing sustained release composition formulated to release non-toxic therapeutic amount of the antimicrobial agent over the time. The examiner believes that there is no lack of fact findings and each and every element of claim 11, and depending claims is taught either by the primary reference or by its combination with the secondary references as set forth in the previous office action. The present invention as a whole is taught by the combination of the references and would have been prima facie obvious in the meaning of USC 103(a).

Applicant argues that Smedley states that the "flow restricting member may be situated in any location within the device." while claim 38 claims "a focal surrounding element that can be altered to shrink and constrict the lumen." The flow restricting device of Smedley will not be able to shrink and constrict the lumen from the inside of the lumen. Furthermore, if the flow-restricting member shrinks it will not be able to "restrict retrograde motion [of blood flow]." If the flow restrictor is no longer able to restrict retrograde motion of blood flow then the proposed modification will render the prior art unsatisfactory for its intended purpose in violation of MPEP 2143.01.

In response to this argument, it is argued that Smedley teaches, in col.9, lines 36-46, flow restricted member that can be a polymer that reads on claim 38. The claim does not recite any more specification of the flow restricting member. Further, the present claims are directed to a product, and the elements of the product are taught by the prior art in combination. The intended function of part of the device does not impart patentability to the claims.

Applicant argues that the office action has failed to present a prima facie obviousness rejection of the preceding claims to which claims 22, 27, and 28 depend. The office action has not presented any facts or evidence showing where Bardenstein cures any of the defects discussed regarding those claims.

In response to this argument, it is argued that Bardenstein is relied upon for the solely teaching of radiologically detectable marker material for the advantage of follow up using simple radiological technique without resorting to complex imaging techniques.

Applicant argues that no further explanation in the office action of why or how claims 34-37 are rejected.

In response to this argument, it is argued that claims 34-37 recite function of the claimed device. All the elements of the claimed device are taught by combination of the references and the claimed function would be exhibited by the device taught by the combination of the prior art.

An applicant argues that Wong does not teach a sustained release medium that is provided as layers.

In response to this argument, it is argued that Wong teaches ocular implantable devices for sustained release of active substances including therapeutic agents to tissues adjacent to the area of implantation (abstract; col.3, lines 32-38; col.5, lines 17-20; col.8, lines 45-64). The implant is multi-layered to deliver two or more active agents to reach different surrounding regions and particularly useful for delivering two or more active substances (col.6, lines 58-63; col.9, lines 26-30). Therefore, multilayered sustained release medium is taught by Wong.